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OFFICE OF PETITIONS

In re Patent No. 7,603,415
Issued: October 13, 2009
Application No. 09/640,103
Filed: August 15, 2000
Attorney Docket No: FKC-100US

: DECISION ON REQUEST
: FOR RECONSIDERATION
: OF PATENT TERM ADJUSTMENT
: AND
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d) filed on December 10, 2009, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 841 days to 1347 days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by nine hundred thirty-seven (937) days is **GRANTED to the extent indicated herein**.

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on August 15, 2003 and ends on January 9, 2006, the day before the RCE was filed, and the B delay considering the 350 days of overlap is 520 days. See 35 U.S.C. 154(b)(1)(B)(i). Non-overlapping B delay is 870 days. Further, patentee fails to account for the filing of two Notices of Appeal on September 4, 2007 and January 26, 2009. The combined 402 days of the over three year period consumed by appellate review, the first period beginning on September 4, 2007 and ending on May 28, 2008, and the second period beginning January 26, 2009 and ending on June 8, 2009, are not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii).

Applicants direct the office to the Supplemental Information Disclosure Statement (IDS) filed January 13, 2005 and argue that there should have been a 14 day deduction for applicant delay.

The Supplemental Information Disclosure Statement filed January 13, 2005 was filed after the filing of a response to the non-Final Office Action on December 30, 2004. In this instance, the filing of the Supplemental Information Disclosure Statement on

January 13, 2005 is considered a failure to engage under 1.704(c)(8). The IDS was not expressly requested by the examiner nor did the IDS include a 1.704(d) statement.

37 CFR 1.704(c)(8) provides that:

the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

Pursuant to 37 CFR 1.704(c)(8) a period of reduction of 14 days counting the number of days in the period beginning on the day after the initial reply was filed, January 1, 2005 and ending on the date of filing of the last supplemental paper, the IDS filed January 13, 2005. Accordingly, a period of reduction of 14 days is being entered.

Applicants argue further that an additional 8 days of Applicant delay should be accorded for the filing on January 10, 2006 of a response to the Final Office Action mailed on August 11, 2005. The three-month deadline for response to the Office Action was November 11, 2005 and a Request for Continued Examination was received by the Office on January 10, 2006, not January 2, 2006, thus a delay of 60 days, rather than the 52 days indicated on the Patent Term Adjustment should be accorded.

A review of the record reveals that the patent term adjustment accorded for applicant delay is incorrect. In this instance, the filing of the response on January 10, 2006 is considered a failure to engage under 1.704(c)(8), counting the number of days in the period beginning November 11, 2005 and ending on January 10, 2006, the date the response to the August 11, 2005 office action was filed. Accordingly, an additional period of reduction of 8 days is being entered.

As such, the patent term adjustment is 937 (1032 "A delay days" + 870 "B delay days" - 350 days overlap - 402 days excluded - 213 applicant delay days), not 1347 days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Additionally, there is no indication that petitioner herein was ever empowered to handle matters related to this patent. If petitioner desires to receive future correspondence regarding this patent, the appropriate power of attorney documentation must be submitted.

If the new power of attorney and/or change of address is signed by an assignee, the assignee must comply with the requirements of 37 CFR 3.73(b). This decision will be mailed to petitioner, however, all future correspondence will be mailed solely to the correspondence address of record. If petitioner desires to receive future correspondence regarding any Maintenance Fee Reminder or any other matter which may be mailed concerning this patent, a Fee Address should be submitted to Maintenance Fee Division.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **nine hundred thirty-seven (937) days**.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

cc:

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DRAFT
UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,603,415 B1

DATED : October 13, 2009

INVENTOR(S) : Patrick McErlean

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (841) days

Delete the phrase "by 841 days" and insert – by 937 days--